



Doc Code: AP.PRE.REQ.

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| | | | | | | | | | | | | |
|---|---|---|--------------------------------|--|---------------------------------------|---|---|---|---|---|------------------------|---|
| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 3194.1005-000 (200300135US) | | | | | | | | | | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>3/17/06</u> Signature <u>Margaret A. Norcutt</u> Typed or printed name <u>Margaret A. Norcutt</u> | | Application Number 09/661,617 | Filed 09/14/2000 | | | | | | | | | |
| | | First Named Inventor Jeffrey J. Spiegelman | | | | | | | | | | |
| | | Art Unit 1743 | Examiner Brian J. Sines | | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td><u>Mary Lou Wakimura</u> Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td><u>Mary Lou Wakimura</u> Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>31,804</u></td><td><u>(978) 341-0036</u> Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td><u>3/17/06</u> Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <table border="1"><tr><td><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</td></tr></table> | | | | <input type="checkbox"/> applicant/inventor. | <u>Mary Lou Wakimura</u> Signature | <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | <u>Mary Lou Wakimura</u> Typed or printed name | <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>31,804</u> | <u>(978) 341-0036</u> Telephone number | <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | <u>3/17/06</u> Date | <input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted. |
| <input type="checkbox"/> applicant/inventor. | <u>Mary Lou Wakimura</u> Signature | | | | | | | | | | | |
| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | <u>Mary Lou Wakimura</u> Typed or printed name | | | | | | | | | | | |
| <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>31,804</u> | <u>(978) 341-0036</u> Telephone number | | | | | | | | | | | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | <u>3/17/06</u> Date | | | | | | | | | | | |
| <input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted. | | | | | | | | | | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jeffrey J. Spiegelman

Application No.: 09/661,617 Group: 1743

Filed: September 14, 2000 Examiner: Brian J. Sines

Confirmation No.: 9556

For: METHOD OF IDENTIFYING FLUID PURIFICATION EQUIPMENT WHICH IS
OPTIMIZED FOR INDIVIDUAL FLUID PURIFICATION SYSTEMS

| | |
|---|---------------------------|
| CERTIFICATE OF MAILING OR TRANSMISSION | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or is being facsimile transmitted to the United States Patent and Trademark Office on: | |
| <u>3/17/06</u> | <u>Theresa A. Norcott</u> |
| Date | Signature |
| <u>Margaret A. Norcott</u> | |
| Typed or printed name of person signing certificate | |

REMARKS LETTER FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following is being submitted together with a Notice of Appeal under 37 C.F.R. § 41.31 and in support of a Pre-Appeal Brief Request for Review in the above-identified application.

In the subject application a Final Office Action dated January 10, 2006 finally rejected Claims 1 and 3-29 under 35 U.S.C. § 103(a) as being unpatentable over Chang (U.S. Patent No. 5,873,263) in view of Hanson et al. (U.S. Patent No. 5,315,521) and further in view of Beelitz et al. (U.S. Patent No. 6,182,275).

Applicant believes these rejections of record are clearly not proper and are without basis. In support of this position, the below presents clear legal and/or factual deficiencies in the rejections.

1. On page 4 of the subject final Office Action, it is stated that Beelitz et al. teaches "...a computer implemented method incorporating the use of a computer system readable relational database and an interactive user interface in configuring, building and selling a customizable computer system (see col. 2, lines 20-67; col. 3, lines 32-43; & col. 4, lines 5-61)" and that "...Beelitz et al...relates effectively to the same problem and solution...as the claimed invention." However, Beelitz et al. does not teach or otherwise imply or suggest the claim limitations of:

"...from across the whole series of sequential inquiries, forming the set of defining information from received user responses; and using said formed set of defining information,... automatically identifies for the user a fluid purification equipment package in its entirety..." from base Claim 1 and similar language in base Claim 28; or

"...receiving user responses to the series of sequential inquiries and therefrom forming said body of defining information; and using said formed body of defining information... automatically identifying for a user one or more fluid purification equipment packages each in its entirety..." from base Claim 29.

This point and the claim limitations regarding (1) forming a body/set of defining information from user responses received across the whole series of inquiries, and (2) automatically identifying for a user a whole solution in its entirety, i.e., "a fluid purification equipment package in its entirety" are argued on page 10, paragraph one through the top of page 11 of Applicant's paper filed October 28, 2005 and re-stated at page 12, middle paragraph of the same paper.

2. With regard to base Claim 29 and dependent claims 12-13, Beelitz et al. does not (nor do Chang or Hanson et al.) imply or suggest the claim limitation of "...automatically identifying for a user one or more fluid purification equipment packages each in its entirety..." as argued on page 13, paragraphs 1 and 2 of Applicant's paper filed on October 28, 2005.

3. At the top of page 6 of the subject final Office Action, it is stated that Beelitz et al. do teach and fairly suggest a "...method of identifying the fluid purification equipment..."

performed in a manner free of the user selecting individual components...that instead of offering the user an explicit choice of an individual component, the disclosed method automatically determines the parameters of the hardware components, such as computer RAM size and the computer operating system (see col. 18, line 45 - col. 19, line 19)." However, the Beelitz discussion of additionally automating the settings of a software program (a component previously chosen by the user from a list) based on the configuration of hardware does not teach or suggest the claim limitation of:

"...automatically identifies for the user a fluid purification equipment package in its entirety... the automatic identification of the fluid purification package being performed in a manner free of user selection from and interaction with lists of individual components in the interactive interface."

as argued on page 11, first full paragraph through the top of page 12 of Applicant's paper filed October 28, 2005.

4. In addition to the cited art not meeting the claim limitations recited in the foregoing paragraphs, the subject final Office Action lacks essential elements for making a prima facie rejection. To establish a prima facie case for obviousness under 35 U.S.C. § 103(a), (1) there must be some suggestion or motivation to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the references once combined must teach or suggest all of the claim limitations.

As argued at page 12, middle paragraph of Applicant's paper filed October 28, 2005, (a) there is no motivation to modify the component by component (i.e., one component at a time) approach of Beelitz et al. in view of the other references to form the automatic identification of whole solutions (entire "package") method of the present invention, and (b) even when combined, the references do not teach or suggest all the claim limitations (for example, see paragraphs 1 and 2 above).

CONCLUSION

According to the foregoing, it is respectfully requested that the panel find:

- (i) that all existing claims are in condition for allowance and that the application should pass to issue,
- or in the alternative
- (ii) that there is allowable subject matter in the claims and prosecution on the merits should be reopened with an appropriate office communication.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Mary Lou Wakimura
Mary Lou Wakimura
Registration No. 31,804
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133

Dated: 3/17/04